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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,938	06/14/2001	Shoichi Nagatomo	01347/LH	7688

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FRISHAUF, HOLTZ, GOODMAN & CHICK, PC  
767 THIRD AVENUE  
25TH FLOOR  
NEW YORK, NY 10017-2023

EXAMINER


GREENE, DANIEL L

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

 <b>Office Action Summary</b>	<b>Application No.</b> 09/881,938	<b>Applicant(s)</b> NAGATOMO ET AL.	
	<b>Examiner</b> Daniel L. Greene	<b>Art Unit</b> 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 41-62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 41-62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |



## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

The applicant has not disclosed that a recording medium be it a semiconductor storage area or a dynamic storage area solves any stated problem in a new or unexpected way or is for any particular purpose which is unobvious to one of ordinary skill and it appears that the claimed feature does not distinguish the invention over similar features in the prior art since, the teachings of Schull will perform the invention as claimed by the applicant with any means, method, or product to read the free and pay contents area, inhibit reading the pay contents area unless predetermined procedures are met and reading the pay contents in accordance with predetermined procedures.

Further, the Applicant appears to be arguing that different memory structure/type would render an application unique, original and non-obvious. The Examiner disagrees and submits memory equivalents do not render an Application unique. As per Microsoft Computer Dictionary, 4th Edition, 1999, page 285, [Microsoft] definition of memory, n. A device where information can be stored and retrieved. In the most general sense, memory can refer to external storage such as disk drives or tape drives: in common usage, it refers only to a computer's main memory, the fast semiconductor storage

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(RAM) directly connected to the processor. See also core, EEPROM, EPROM, flash memory, PROM, RAM, and ROM, Computer bubble memory, Mass storage. The teachings of Schull will perform the invention as claimed by the applicant with any means, method, or product to read the free and pay contents area, inhibit reading the pay contents area unless predetermined procedures are met and reading the pay contents in accordance with predetermined procedures regardless of the memory structure/type used.

Claims 1-40 have been cancelled. Claims 41-62 are pending.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 41-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schull U.S. Patent 5,509,070 [Schull].**

PTO's guide lines for examining claimed language require: the examiner must make a determination, whether the claimed invention "as a whole" would have been obvious at the time of the invention to one of ordinary skill in the art. See MPEP 2142. In these pending claims, the examiner submits that the particular language, "... a first semiconductor storage area and a second dynamic storage are..." does not serve as a

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limitation on the claim. Schull discloses, "... the Programmer's Program looks in an information storage location for a "Previously Installed Password 40." Col. 5, lines 33-35. Schull goes on to teach, " In a computer, the information storage location would typically be a file on a hard disk drive, but in principle the Password could be installed in any location accessible by the Programmer's Program." Col. 5, lines 35-40.

As per Microsoft Computer Dictionary, 4th Edition, 1999, page 285, [Microsoft] definition of memory, n. A device where information can be stored and retrieved. In the most general sense, memory can refer to external storage such as disk drives or tape drives: in common usage, it refers only to a computer's main memory, the fast semiconductor storage (RAM) directly connected to the processor. See also core, EEPROM, EPROM, flash memory, PROM, RAM, and ROM, Computer bubble memory, Mass storage. The teachings of Schull will perform the invention as claimed by the applicant with any means, method, or product to read the free and pay contents area, inhibit reading the pay contents area unless predetermined procedures are met and reading the pay contents in accordance with predetermined procedures regardless of the memory structure/type used.

Schull further discloses:

a data reader; Col. 5, line 7, User's Processor.

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means for reading the free and pay contents data; Fig. 1

means for inhibiting the reading means from reading the pay contents data by referring to the information stored in the first semiconductor storage Area; Fig. 1, **60**

means for permitting the reading means to read the pay contents in accordance with predetermined procedure by referring to the information stored in the first semiconductor storage area. Fig. 1, **93, 100**.

As per claims 42, 47, 53, 58:

Schull discloses the claimed invention except for connecting the recording medium to a server system of a center on the Internet. However, Schull does disclose the use of two communications and teaches, " The User acquires freely-copy able software through the "Laissez Faire Distribution Channel" **10** which comprises all of the methods previously described as non-traditional distribution channels as well as other distribution methods which might be developed in order to exploit the present invention" Col. 5, lines 1-6. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to connecting the recording medium to a server system of a center on the Internet since it is known in the art that use of the Internet for two way communications is common and well known.

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As claims 44 and 55:

Schull further discloses:

wherein the inhibiting means is provided on the recording medium. Col. 14, lines 40-50.

As per claims 45 and 56:

Schull further discloses:

wherein the inhibiting means is provided in the data reader. Col. 5, lines 30-40.

As per claims 46 and 57:

Schull further discloses:

wherein the recording medium comprises means for converting the free contents data to pay contents data in accordance with the predetermined procedures, Col. 11, lines 10-25.

As per claims 49 and 60:

Schull further discloses:

wherein the inhibiting means is provided in the server system. Col. 15, lines 13-35.

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As per claims 50 and 61:

Schull discloses the claimed invention except for wherein said predetermined procedures comprise payment of a required charge to the center. However, Schull does teach about different methods for acquiring payments, Col. 11, lines 8-25. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to wherein said predetermined procedures comprise payment of a required charge to the center since it is known in the art that payment procedures are normally handled by some type or kind of center.

As per claims 51 and 62:

Schull further discloses:

wherein the predetermined procedures comprise inputting authentication data from the reader to the server system. Col. 7, lines 1-40.

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.



***Conclusion***

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

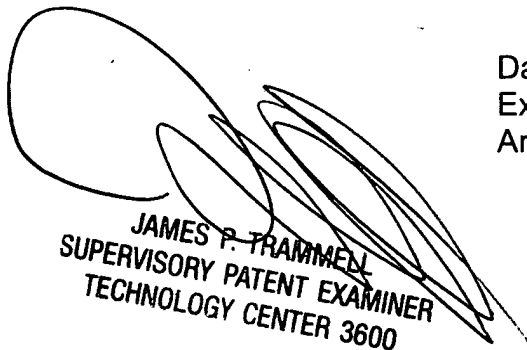
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene whose telephone number is 703-306-5539. The examiner can normally be reached on M-Thur. 8am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

3/10/2005

  
JAMES P. TRAMMELL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600

Daniel L. Greene  
Examiner  
Art Unit 3621